

REMARKS

This paper is filed in response to the Office Action mailed October 15, 2010 (the “Office Action”).

Claims 80-90, 92-101, and 103-105 are pending in this application. Claims 80-90, 92-101, and 103-105 were rejected under the judicially-created doctrine of obviousness-type double patenting over U.S. Patent Nos. 5,956,484, 6,101,530, 6,161,126, 6,125,385, 6,353,850, 6,859,819, and 7,636,080. Claims 95-101 and 103-105 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Claims 80-85, 90, 92-96, 101, and 103-105 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,908,467 to Barrett et al (“Barrett”). Claims 86-89 and 97-100 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Barrett in view of U.S. Patent No. 5,669,818 to Thorner et al (“Thorner”).

Applicant has amended claims 95 and 103. No new matter is added by these amendments and support may be found in the specification and claims as originally filed.

Applicant traverses each of the rejections of the claims and respectfully requests reconsideration and allowance of all claims in view of the amendments above and the remarks below.

I. Double Patenting

To obviate the double patenting rejection, Applicant submits herewith a Terminal disclaimer over each of U.S. Patent Nos. 5,956,484, 6,101,530, 6,161,126, 6,125,385, 6,353,850, 6,859,819, and 7,636,080. Applicant respectfully requests the Examiner withdraw the double patenting rejection of claims 80-90, 92-101, and 103-105.

II. § 101 – Claims 95-101 and 103-105

Claims 95-101 and 103-105 were rejected as allegedly claiming a pure signal computer-readable medium. Applicant has amended independent claims 95 and 103 to recite a “non-transitory” computer-readable medium. The USPTO has noted that computer-readable medium claims that cover “both transitory and non-transitory embodiments may be amended to narrow

the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation ‘non-transitory’ to the claim.”¹ Further, the USPTO has noted that

“[s]uch an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory embodiment because a signal *per se* is the only viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure.”²

For the purposes of this application, the term “non-transitory” is intended to encompass computer-readable media as defined within the present specification and those that would otherwise be known to one of skill in the art, but excludes transitory, propagating signals as defined in Nuijten.³ The specification provides multiple examples of non-transitory computer readable media, including “RAM, ROM, hard disk,” etc.⁴ Each of these is a non-transitory computer-readable medium. Further, given the USPTO’s position that (a) such an amendment obviates a rejection under 35 U.S.C. § 101, and (b) that such an amendment does not constitute the addition of new matter so long as non-transitory embodiments are disclosed, Applicant respectfully asserts that amended independent claims 95 and 103, and consequently dependent claims 96-101, 104, and 105, are directed to patentable subject matter. Therefore, Applicant respectfully requests the Examiner withdraw the rejection of claims 95-101 and 103-105.

III. § 102(b) – Claims 80-85, 90, 92-96, 101, and 103-105– Barrett

Applicant respectfully traverses the rejection of claims 80-85, 90, 92-96, 101, and 103-105 under 35 U.S.C. § 102(b) as allegedly being anticipated by Barrett.

To anticipate a claim under 35 U.S.C. § 102(b), a reference must disclose each and every element of the claimed invention.⁵

Because Barrett does not disclose “receiving an input signal from a network, the input signal comprising an embedded force feedback command” as recited in claim 80, Barrett does

¹ Subject Matter Eligibility of Computer Readable Media, signed by Director Kappos on Jan. 26, 2010.

² *Id.*

³ In re Nuijten, 500 F.3d 1346, 1352, 1357 (Fed. Cir. 2007).

⁴ Specification, page 11, lines 1-2.

⁵ M.P.E.P. § 2131.

not anticipate claim 1. The Examiner argues that data indicating a file size of web page received from a server is a “force feedback command” because the computer that receives the data may determine, based on the file size, that force feedback should be output to a trackball or other manipulandum.⁶ However, the Examiner’s interpretation of the term “force feedback command” is unreasonably broad and is simply synonymous with “data.” Any data may “result[] in the production of force feedback” depending on how the receiver of the data chooses to use the data. Further, Barrett does not disclose that the file size information is a command of any kind, and thus it cannot be a force feedback command. Therefore, Barrett does not disclose “receiving an input signal from a network, the input signal comprising an embedded force feedback command” as recited in claim 80 and so Barrett does not anticipate claim 80. Applicant respectfully requests the Examiner withdraw the rejection of claim 80.

Each of claims 92 and 103 recite “embedding the force feedback command in an output signal; [and] transmitting the output signal to a network” and each is patentable over Barrett for at least the same reasons as claim 80. Applicant respectfully requests the Examiner withdraw the rejection of claims 92 and 103.

Because claims 81-85, 90, 93-96, 101, 104, and 105 each depend from and further limit one of claims 80, 92, or 103, each of claims 81-85, 90, 93-96, 101, 104, and 105 is patentable over Barrett for at least the same reasons. Applicant respectfully requests the Examiner withdraw the rejection of claims 81-85, 90, 93-96, 101, 104, and 105.

IV. § 103(a) – Claims 86-89 and 97-100 – Barrett in view of Thorner

Applicant respectfully traverses the rejection of claims 80-85, 90, 92-96, 101, and 103-105 under 35 U.S.C. § 102(b) as allegedly being anticipated by Barrett.

To establish *prima facie* obviousness of a claimed invention under 35 U.S.C. § 103, the Office Action must show, either from the references themselves or in the knowledge generally available to one of ordinary skill in the art, that the cited references disclose or suggest each claimed element.⁷

⁶ Office Action at 23 (“comprising ‘information indicative of the size of the page’: see col. 5, line 63 to col. 6, line 2; note that the information is a “force feedback command” because it results in the production of force feedback: see col. 7, lines 34-42.”)

⁷ See Graham v. John Deere Co., 383 U.S. 1 (1966), KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398 (2007).

Because Barrett in view of Thorner does not disclose or suggest "receiving an input signal from a network, the input signal comprising an embedded force feedback command" as recited in claim 80, from which claims 86-89 depend, claims 86-89 are patentable over Barrett in view of Thorner. As discussed above, Barrett does not disclose "receiving an input signal from a network, the input signal comprising an embedded force feedback command." Thorner does not cure this deficiency. Therefore, claims 86-89 are each patentable over Barrett in view of Thorner. Applicant respectfully requests the Examiner withdraw the rejection of claims 86-89.

Similar to claim 80, claim 92, from which claims 97-100 depend, recites "embedding the force feedback command in an output signal; [and] transmitting the output signal to a network." Therefore, claims 97-100 are patentable over Barrett in view of Thorner for at least the same reasons. Applicant respectfully requests the Examiner withdraw the rejection of claims 97-100.

CONCLUSION

Applicant respectfully asserts that in view of the amendments and remarks above, all pending claims are allowable and Applicant respectfully requests the allowance of all claims.

Should the Examiner have any comments, questions, or suggestions of a nature necessary to expedite the prosecution of the application, or to place the case in condition for allowance, the Examiner is courteously requested to telephone the undersigned at the number listed below.

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Respectfully submitted,



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